



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,537	09/22/2003	John Frederick Heck	LUC-424/Heck 4-1	9945
32205	7590	07/27/2005	EXAMINER	
PATTI & BRILL ONE NORTH LASALLE STREET 44TH FLOOR CHICAGO, IL 60602			LAM; DUNG LE	
			ART UNIT	PAPER NUMBER
			2687	

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/667,537

Applicant(s)

HECK ET AL.

Examiner

Dung Lam

Art Unit

2687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/22/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Information Disclosure Statement*

1. The references listed in the Information Disclosure Statement submitted on March 02, 2005 have been considered by the examiner (see attached PTO-1449 form). Please note that the listed prior art document number "2003/040300" is missing a zero, it <sup>has been</sup> ~~should~~ be changed to --2003/0040300--.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **1-8, 10-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bodic et al.** (US Pub. No. 2003/0040300) in view of **Muhonen** (WO 99/66746).

3. Regarding **claim 1**, **Bodic** teaches a method for delivering a non-multimedia message to a multimedia messaging service, MMS, enabled handset comprising the steps of (Abstract):

receiving the non-multimedia message (SMS) at a message server in a mailbox assigned to a recipient of the non-multimedia message (col. 4, para. 64);

Art Unit: 2687

determining if the recipient utilizes an MMS enabled handset (col 3, para. 47 and col. 4, para. 64);

transmitting the information contained in the non-multimedia message to the recipient utilizing a communication mode supported by the MMS enabled handset of the recipient (col. 4, para. 64).

However, Bodic does not teach the steps of storing the non-multimedia message at a message server in a mailbox assigned to a recipient of the non-multimedia message; if the recipient utilizes an MMS enabled handset, causing a short messaging service, SMS, notification message to be generated and transmitted to the recipient's handset, the notification message communicating to the recipient that a message is awaiting delivery to the recipient; upon receipt of a deliver message originated by the recipient's handset at the message server, transmitting the message to the handset of the recipient.

In an analogous art, **Muhonen** teaches the step of storing the message at a message server in a mailbox assigned to a recipient message (page 21, lines 24-25); a notification message to be generated and transmitted to the recipient's handset, the notification message communicating to the recipient that a message is awaiting delivery to the recipient (page 15, lines 11-13); upon receipt of a deliver message originated by the recipient's handset at the message server (page 16, lines 4-6), transmitting the message to the handset of the recipient (page 16, lines 18-22). Muhonen further teaches the motivation that sometimes the recipient may not want to or not able to receive the message due to inadequate memory of the handset (page 21, lines 2-5) and that notification

Art Unit: 2687

message can contain more details about the message that makes it easier for recipient to decide whether or not to retrieve the message (page 15, lines 16-20). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Bodic's method of sending a non-MMS message to a MMS enabled handset with Muhonen's teaching of sending a notification of the awaiting message prior to actual transmission of the message to increase bandwidth efficiency by sending out the message only when the message is desired and requested by the recipient.

4. Regarding **claim 2, Bodic and Muhonen** teach a method according to claim 1. Bodic further teaches that the non-multimedia message is a conventional voicemail message and wherein the method comprises further steps of storing at the message server the conventional voicemail message as data utilizing a first digital format and translating the voicemail message from the first digital format into another format compatible with the communication mode supported by the MMS enabled handset of the recipient (col. 4, para. 64).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to translate the message into a displayable format for the receiving handset to reduce potential complaints from customers for presenting incomprehensible messages.

5. Regarding **claim 3, Bodic and Muhonen** teach a method according to claim 1. Bodic further teaches the step of receiving includes receiving the non-

Art Unit: 2687

multimedia message from a source that does not support MMS (col. 4, para. 64).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made make the communication system more compatible with the newer and versions of handsets.

6. Regarding **claims 4-6**, they are apparatus claims corresponding the method claims 1-3 respectively. Therefore, they are rejected for the same reasons as 1-3 (see claims 1-3 above).

7. Regarding **claim 7**, **Bodic** teaches a method for delivering at least a portion of a multimedia message originated by a multimedia messaging service, MMS, enabled handset to a non-MMS enabled handset comprising the steps of (Abstract):

receiving the multimedia message (MMS) at a message server in a mailbox assigned to a recipient of the multimedia message (col. 4, para. 66);

determining if the recipient utilizes an MMS enabled handset (col 3, para. 47-48);

transmitting the information contained in the multimedia message to the recipient utilizing a communication mode supported by the non-MMS enabled handset of the recipient (col. 4, para. 66).

However, Bodic does not expressly teach the steps of storing the multimedia message at a message server in a mailbox assigned to a recipient of the multimedia message; if the recipient utilizes an SMS enabled handset,

Art Unit: 2687

causing an SMS notification message to be generated and transmitted to the recipient's handset, the notification message communicating to the recipient that a message is awaiting delivery to the recipient; upon receipt of a call from the recipient at the message server seeking access to the multimedia message awaiting delivery in the recipient's mailbox, transmitting at least a portion of the information contained in the multimedia message to the recipient utilizing a communication mode supported by the non-MMS enabled handset of the recipient.

In an analogous art, **Muhonen** teaches the step of storing the message at a message server in a mailbox assigned to a recipient message (page 21, lines 24-25); a notification message to be generated and transmitted to the recipient's handset, the notification message communicating to the recipient that a message is awaiting delivery to the recipient (page 15, lines 11-13); upon receipt of a deliver message originated by the recipient's handset at the message server (page 16, lines 4-6), transmitting the message to the handset of the recipient (page 16, lines 18-22). Muhonen further teaches the motivation that sometimes the recipient may not want to or not able to receive the message due to inadequate memory of the handset (page 21, lines 2-5) and that notification message can contain more details about the message that makes it easier for recipient to decide whether or not to retrieve the message (page 15, lines 16-20). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Bodic's method of sending a MMS message to a non-MMS enabled handset with Muhonen's teaching of sending a

Art Unit: 2687

notification of the awaiting message prior to actual transmission of the message to increase bandwidth efficiency by sending out the message only when the message is desired and requested by the recipient.

8. Regarding **claim 8**, **Bodic and Muhonen** teach a method according to claim 7. **Bodic** further teaches that the multimedia message contains at least a voice message portion and wherein the method comprises further steps of storing at the message server the voice message portion as data utilizing a first digital format and translating the voice message portion from the first digital format into another format compatible with the communication mode supported by the non-MMS enabled handset of the recipient (col. 4, para. 66).

9. Regarding **claims 11**, they are apparatus claims corresponding to the respective method claims 7-9. Therefore, they are rejected for the same reasons as (see claims 7-9 above).

10. Claims **10 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bodic et al.** (US Pub. No. 2003/0040300) in view of **Muhonen** (WO 99/66746) further in view of **Eales et al.** (US Pub. No. 2005/0083940).

11. Regarding **claim 9**, **Bodic and Muhonen** teach a method according to claim 7. They further teach that the multimedia message contains at least a first message portion and wherein the method comprises further steps of determining

Art Unit: 2687

if the recipient's handset is capable of receiving the communication mode utilized by said first message portion. However, they fail to explicitly teach that and upon determining that the recipient's handset is not capable of receiving the communication mode, generating a notice message transmitted to the recipient's handset informing the recipient that a portion of the multimedia message could not be communicated to the recipient. In an analogous art, **Eales** teaches that upon receiving a MMS message destined for a legacy (non-MMS) handset, a message is forwarded to the receiving legacy handset notifying the receiver of an MMS message awaiting to be delivered (col. 5, para. 82). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to add to Bodic and Muhonen's teachings the notification feature as taught by Eales to increase the quality and compatibility in messaging between SMS and MMS handsets.

12. Regarding **claims 12**, it is an apparatus claim of a message server corresponding to the respective method claims 9. Therefore, it is rejected for the same reasons as (see claim 9 above).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung Lam whose telephone number is (571) 272-6497. The examiner can normally be reached on M - F 8-5pm.

Art Unit: 2687

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL  
7/24/2005

  
2/25/05  
LESTER G. KINCAID  
SUPERVISORY PRIMARY EXAMINER